

Amendments to the Drawings:

The attached sheets of drawings includes changes to Figures 1-4 and 6.

These sheets, which includes Figures 1-6, replace the original sheets including Figures 1-6.

Appendix A: Replacement Sheets

REMARKS

Upon entry of this amendment, independent claim 1 with dependent claims 2-6 and 8-20 will be present in the application.

Claims 1, 3-6 and 15-20 have been amended to substitute "is movable" for "can be moved". Claim 1 has also been amended to include the limitations of claim 7, which has been canceled, and to further recite that the diaphragm defines at least one substantially rectangular slit disposed in said beam path and that the at least one slit is rotatable from a first orientation within the beam path to a second orientation within the beam path. Such apparatus is disclosed on page 7, lines 28-38, of the specification. Accordingly, the amendments do not introduce new matter.

The drawings were objected to for using solid black shading and for having numbers and reference characters that were not plain and legible. Substitute drawings are submitted herewith correcting these deficiencies. The drawings were also objected to "because reference characters '10, 11, 12' (see Figure 2) have been used to designate both elements in a beam path and elements of the eye." The Applicant respectfully submits that this statement is untrue. The elements designated "10, 11, 12" at the lower part of Figure 2 are the portions of the beam paths within the eye 4. This is more easily seen now that the shading has been removed from the eye shown in Figure 2.

Claims 1-3, 5, 6, 8, 9, 11, 15, 18, and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 5,258,791 (Penney et al.). Claims 1, 2, 4, 5, 7-13, 16, 18, and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 4,671,631 (Sigelman), the Office Action alleging that "the diaphragm may be rotated about an axis parallel to the optical axis of the illuminating beam path (See 233, 234 in Figures 9-10); the diaphragm is arranged in a diaphragm support which is rotatably mounted eccentrically with respect to the optical axis of the illuminating beam path (See 233, 234 in Figures 9-10); ... the diaphragm or at least one diaphragm is slit-shaped or circular (See 240, 241, 242 in Figure 10a; 250, 251, 252, 253, 254 in Figure 10b)". Claims 4, 7, 12, 14, 16, 17, and 20 were rejected under 35 USC §103(a) as being obvious over Penney, the Office Action alleging that "Penney et al. additionally discloses a second embodiment ... wherein a scanning disk having an axis of rotation that is parallel to the optical axis of the

illuminating beam path is used to scan a light patch across the retina of the eye (See 132, 134 in Figure 4; cot. 14, line 43-cot. 15, line 2; cot. 18, lines 29-65). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the diaphragm of the operation microscope of Penney et al., further be rotated about an axis parallel to the optical axis of the illuminating beam path, to allow for extremely fast, repetitive, and repeatable scanning of the light patch, reducing the required measurement time." Claim 10 was rejected under 35 USC §103(a) as being obvious over Penney in view of Sigelman.

Claim 1 has been amended to recite that the diaphragm is rotatable about an axis parallel to the optical axis of the illuminating beam path whereby the slit is rotatable from a first orientation within the beam path to a second orientation within the beam path. Although the disk 234 of the Sigelman reference is rotatable about hole 255, Sigelman specifically teaches that this only enables "the user to position the disks with the desired aperture and desired filter centered within the tubes 68 and 70." Accordingly, slits 251-254 will be stationary and centered within tubes 68 and 70 when the ophthalmoscope is used. Further, when the slits 251-254 are positioned for use, each of the slits will the same orientation in tubes 68 and 70. Penney teaches that "scanning mechanism (rotating disk 132) scans the measurement beam or measurement point along the surface of the eye in a predetermined pattern. ... The scan pattern may follow a predetermined path (such as a raster scan), may follow a random path or a path which is dependent on the results of previous measurements, or any other desired path." Accordingly, Penney specifically teaches that the function of the rotating disk is to move the measurement beam along the surface of the eye. Rotating disk 132 will not change the orientation of the orifice in the rotating disk, and in fact cannot change the orientation of the circular orifices shown in Figure 4.

"It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention." Transco Products Inc. v. Performance Contracting Inc., 23 USPQ2d 1691, 1694 (N.D. Ill. 1992), see also Hybritech Inc. v. Monoclonal Antibodies, Inc., 213 USPQ 81 (Fed. Cir. 1986) and Stoller v. Ford Motor Co., 18 USPQ2d 1545, 1547 (Fed. Cir. 1991). As shown above, none of the cited references include the diaphragm now


recited in claim 1. Accordingly, the rejections of claim 1 under 35 U.S.C. § 102(b) must be withdrawn.

"It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." Northern Telecom Inc. v. Datapoint Corp., 15 USPQ2d 1321, 1323 (Fed. Cir. 1990). "There must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985). Without the hindsight provided by the disclosure of the subject application, it cannot logically be argued that it would be obvious to modify the apparatus of either of the cited patents to include a diaphragm that is rotatable about an axis parallel to the optical axis of the illuminating beam path whereby the slit is rotatable from a first orientation within the beam path to a second orientation within the beam path. While Sigelman teaches that the diaphragm may be rotatable, such rotation is merely used to change the physical dimensions of the slot. While Penney teaches that the diaphragm may be rotated to move the light beam over the surface of the eye along a prescribed path, the circular orifices of the diaphragm are not physically capable of being rotated to produce different orientations.

The various dependent claims add additional features to the independent claims, and are therefore believed to be allowable. Also, the dependent claims are believed patentably distinct on their own merits as being directed to combinations not suggested by the references.

In view of the above-directed amendments and the proceeding remarks, prompt and favorable reconsideration is respectfully requested.

Respectfully submitted,
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